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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/585,067

06/29/2006

Hiroyuki Tanaka

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SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

BUIE, NICOLE M

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

11/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/585,067	<b>Applicant(s)</b> TANAKA ET AL.	
	<b>Examiner</b> NICOLE M. BUIE	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 1-7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20060629/20081003</u> .                                       | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

**Claims 1-7** are objected to because of the following informalities: the parentheses surround the limitation “except for amorphous carbon” is objected because it is unclear whether the limitations within the parentheses are part of the claimed invention. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1 and 3-5** are rejected under 35 U.S.C. 102(b) as being anticipated by Stewart (US 4,503,171).

**Regarding claims 1 and 3**, Stewart discloses a fluorine-containing elastomer composition comprising a perfluoroelastomer and graphite having an average primary particle size of about from 0.01 nm to 10 nm (C2/L11-26).

**Regarding claim 4**, the recitation of a new intended use (i.e. for semiconductor manufacturing equipment) for an old product does not make a claim to that old product patentable. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). See MPEP § 2111.02.

**Regarding claim 5**, Stewart discloses a molded article (Examples I-IV).

**Claim 7** is rejected under 35 U.S.C. 102(b) as being anticipated by Stewart (US 4,503,171).

**Regarding claim 7**, Stewart discloses a filler comprising graphite having an average primary particle size of about from 0.01 nm to 10 nm (C2/L11-26). The recitation of a new intended use (i.e. for a sealing material in semiconductor manufacturing equipment) for an old product does not make a claim to that old product patentable. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). See MPEP § 2111.02.

**Claims 1-5** are rejected under 35 U.S.C. 102(b) as being anticipated by Sawaguchi et al. (JP 2004-051937 A, see machine translation for citation).

**Regarding claims 1-3**, Sawaguchi et al. discloses a fluorine-containing elastomer composition comprising a perfluoroelastomer (i.e. polytetrafluoroethylene) [0009] and nanodiamond (Claim 1, [0001]) having an average primary particle size of 1 to 10 nm [0006].

**Regarding claim 4**, the recitation of a new intended use (i.e. for a semiconductor manufacturing equipment) for an old product does not make a claim to that old product

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patentable. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). See MPEP § 2111.02.

Regarding claim 5, Sawaguchi et al. discloses a molded article [0021].

**Comment [M1]:** PTFE homopolymer is a plastic, not an elastomer. Discussion of the rubbers begins three lines after its mention in [0009]. Perhaps you could make the case that a 103 rejection is merited since the reference seems to be indicating that the novelty in their invention lies with the filler and it may be added to basically any polymer host but a 102 would not be proper.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (US 4,503,171) as applied to claim 1 above as evidenced by Amin et al. (US 5,461,107).

**Regarding claim 6**, Stewart discloses a composition as shown above in claim 1.

However, Stewart does not disclose a sealing material comprising the fluorine-containing elastomer composition. The selection of a known material based on its suitability for its intended use as evidenced by Amin et al. (C1/L15-33) supported a *prima facie* obviousness determination

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in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See MPEP § 2144.07.

**Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Sawaguchi et al. (JP 2004-051937 A, see machine translation for citation) above as evidenced by Amin et al. (US 5,461,107).

**Regarding claim 6**, Sawaguchi et al. discloses a composition as shown above in claim 1.

However, Sawaguchi et al. does not disclose a sealing material comprising the fluorine-containing elastomer composition. The selection of a known material based on its suitability for its intended use as evidenced by Amin et al. (C1/L15-33) supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See MPEP § 2144.07.

**Comment [M2]:** claim 6 could be rejected as part of a new rejection over Sawaguchi

### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE M. BUIE whose telephone number is (571)270-3879. The examiner can normally be reached on Monday-Thursday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. M. B./  
Examiner, Art Unit 1796  
11/19/2008

/Marc S. Zimmer/  
Primary Examiner, Art Unit 1796

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